



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/978,632 11/25/97 RABBANI E ENZ-53 (C)

028169
ENZO THERAPEUTICS, INC.
C/O ENZO BIOCHEM INC.
527 MADISON AVENUE 9TH FLOOR
NEW YORK NY 10022

HM12/0828

EXAMINER

SCHMIDT, M

ART UNIT

PAPER NUMBER

1635

DATE MAILED:

23
08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/978,632

Applicant(s)

RABBANI ET AL.

Examiner

Mary Schmidt

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 246-270 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 246-270 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

KATRINA TURNER
PATENT ANALYST

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: ____.

Art Unit: 1635

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/19/01 has been entered.

Claim Rejections - 35 USC § 112

2. New claims 246-270 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the same reasons of record as set forth in the Official action mailed 02/03/99, 11/08/99 and 12/19/00 for old claims 1-24 and 245.

The scope of the invention has not changed by the addition of new claims such that one of skill in the art would not face the same problems as addressed with prior claims 1-24 and 245. The new claims are broadly drawn to any non-naturally occurring non-native polynucleotide construct having very broad limitations. As such, the breadth of possible constructs is not considered enabled by one skilled in the art at the time the invention was made.

Art Unit: 1635

3. New claims 246-270 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the same reasons of record as set forth in the Official action mailed 02/03/99, 11/08/99 and 12/19/00 for old claims 1-24 and 245.

The scope of the invention has not changed by the addition of new claims such that one of skill in the art would not face the same problems as addressed with prior claims 1-24 and 245. The new claims are broadly drawn to any non-naturally occurring non-native polynucleotide construct having very broad limitations. As such, the breadth of possible constructs is not considered in possession by one skilled in the art at the time the invention was made.

Claim Rejections - 35 USC § 102

4. New claims 246-270 stand rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al. for the same reasons of record as set forth in the Official action mailed 02/03/99, 11/08/99 and 12/19/00 for old claims 1-24.

The claims still broadly read on a wide scope of possible nucleic acid constructs. Meyer et al. teach non-naturally occurring constructs which produce an antisense product in the cell having the claimed limitations.

Application/Control Number: 08/978,632

Page 4


Art Unit: 1635

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *John LeGuyader*, may be reached at (703) 308-0447.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Analyst, *Katrina Turner*, whose telephone number is (703) 305-3413.

M. M. Schmidt
August 26, 2001


ANDREW WANG
PRIMARY EXAMINER